

48. The method of claim 44, wherein the one of the credit card and the charge card of the client is issued by the organization.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on October 9, 2002, and the references cited therewith.

No claims are amended, cancelled, or added; as a result, claims 1-48 are now pending in this application.

§103 Rejection of the Claims

Claims 1 was rejected under 35 USC § 103(a) as being unpatentable over Egendorf (U.S. 5,794,221). Claims 2-48 were also rejected under 35 USC § 103(a) as being unpatentable over Egendorf in view of Landry (U.S. 5,649,117).

The Examiner stated that patentable weight would not be given to the claimed term "patent and trademark fees" because it merely describes the purpose of the claimed method. Applicants respectfully disagree, and point out that unique structural and method requirements are used to manage this specific type of data and are recited throughout the claims and specification (*see, e.g.*, claim 1 discussion of a firm, a client, a matter having an identifier, a charge for fees related to the matter, etc.). These terms themselves further distinguish the structure and function of the pending claims from the cited references, as explained in greater detail below.

Egendorf discusses a system in which an Internet service provider bills a customer for various purchases of third-party vendor products or services, such that the provider pays the vendor the billed amount minus a transaction fee.

Egendorf does not contemplate identifying a particular matter of a client of a firm, or any other analogous system in which a regular client of an organization identifies a particular transaction by inputting matter identification. Egendorf further fails to contemplate a firm or functionally similar organization inputting the matter identification and billing information into a

computer workstation, but contemplates only a client's self-initiated online transactions.

Egendorf further fails to contemplate an account maintained either by Egendorf's service provider or by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in the claims.

Egendorf also fails to consider generating an invoice for such services, as neither the services nor account are present, but further fails to consider calculating a bill payable to the account associated with the client in such a way as the account maintains a positive balance.

Finally, applicant respectfully objects to the single reference rejection and presumed official notice therewith, and pursuant to MPEP §2144.03 respectfully requests that references showing each element of each rejected claim be cited.

Landry is relied upon in rejecting certain of the pending claims to show that receiving notice of an event relating to a matter of a client of the firm will require a second fee be paid by a due date, and issuing an invoice to ensure that the account associated with the client is prefunded to maintain a positive balance after payment of the second fee on the due date. The cited sections of Landry in fact discuss only a system in which a recurring obligation is paid from payor to payee at a regular time interval, and generation of a bill at the regular intervals for the recurring obligation amount that is used to generate TCF and EFT messages causing the funds to be transferred. Landry does not consider payment of a second fee, whether related to a matter of a client of a law firm or otherwise, and further fails to discuss maintaining an account associated with a client of a firm at a predetermined level in anticipation of upcoming fees due.

The remaining claims are believed to be in condition for allowance as dependent on an allowable base claim, or for the same reasons as discussed above. Reexamination and allowance of pending claims 1-48 is therefore respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-349-9581) to facilitate prosecution of this application.

RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/240,456

Filing Date: January 29, 1999

Title: IMPROVED COMPUTERIZED PATENT AND TRADEMARK FEE PAYMENT METHOD AND SYSTEM

Page 12

Dkt: 684.002US1

If necessary, please charge any additional fees or credit overpayment to Deposit Account

No. 19-0743.



Respectfully submitted,

STEVEN W. LUNDBERG

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 349-9581

Date

Jan 8 '03

By

[Signature]

John M. Dahl

Reg. No. 44,639

RECEIVED
JAN 21 2003
GROUP 3600

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 9th day of January, 2003.

Anne M. Richards

Name

Signature

[Signature]